

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

MAY 31 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MARKUS SCHEUBER and HANS FREI

Application No. 09/876,760

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 8, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

- 1) The Examiner's Answer mailed November 15, 2004, is defective because:

On page 3 of the Examiner's Answer, the examiner has a heading listed as "**(7) Grouping of Claims**" and beneath the heading, he informs appellants that because there is no statement indicating separate arguments of the claims, all claims stand or fall together. In support of his determination, he cites 37 CFR 1.192(c)(7).

We note that the appeal brief was filed on September 20, 2004 and as such is subject to the **New Rules of Practice before the BPAI** effective September 13, 2004.<sup>1</sup> Under the new rules, a ***Grouping of Claims*** heading is no longer one of the requisite heading for an appeal brief, and 1.192(c)(7) is no longer a 37 CFR statute. Therefore, the examiner's reference to the statute is in error.

2) The Appeal Brief filed on September 20, 2004, does not fully comply with all the requirements of 37 CFR 41.37(c) because:

- a. The Appeal Brief (as entitled) was filed under 37 CFR § 1.192 which was no longer in effect at the time of the filing of the brief (see footnote 1 below),
- b. The Appeal Brief lacks, an appropriate heading identifying the *Evidence appendix*, pursuant to 37 CFR § 41.37 (c)(1)(ix), and
- c. The Appeal Brief lacks, an appropriate heading identifying the *Related proceedings appendix*, pursuant to 37 CFR § 41.37 (c)(1)(x).

Accordingly, it is

ORDERED that the application is being returned to the Examiner for

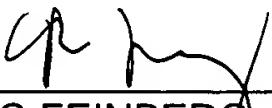
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<sup>1</sup> Attention is drawn to the fact that the Rules of Practice before the Board of Patent Appeals and Interferences have changed effective September 13, 2004. The new rules are set forth at 69 Federal Register 49960, which may be accessed via the internet at <http://www.uspto.gov/web/offices/com/sol/notices/69fr49960.pdf>

- aa) The examiner to obtain a Supplemental Appeal Brief from appellant filed under the new Rules of Practice before the BPAI, effective September 13, 2004, calling attention to the requisite brief headings noted above,
- bb) The examiner to submit a supplemental Examiner's Answer that is in compliance with the new Rules of Practice before the BPAI, effective September 13, 2004, and
- cc) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

  
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